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REMARKS

Claims 20-28 and 49-52 are pending in this application. Claims 1-19 and claims 29-48 are cancelled. Applicants note that the Examiner has indicated that claims 20-23 and 49 are in condition for allowance.

The Examiner rejected claims 29-32 under 35 U.S.C. § 102(b) as being anticipated by Milo (U.S. Patent No. 3,855,578). Applicants have cancelled claims 29-32, thereby mooting the rejection.

The Examiner rejected claims 24, 25, 27, 28 and 50-52 under 35 U.S.C. § 103(a) as being unpatentable over Milo in view of Hu (U.S. Patent No. 6,331,158), and rejected claim 26 as being unpatentable over Milo in view of Hu and in view of Farascini (U.S. Patent No. 5,976,080). Applicants traverse these rejections.

The claimed configuration is clearly shown in Figures 20A and 20B of the application. Claim 24 claims a device for holding a medical instrument that includes an arm having a plurality of links, a body and a base link having a proximal end and a distal end, and being aligned with the body on the proximal end along a first axis and being aligned with one of the plurality of links on the distal end along a second axis, wherein the second axis forms an angle with the first axis of between 45 and 90 degrees. Claim 50 claims a device for holding a medical instrument that includes a body, an arm having a plurality of links, a base link disposed between the body and the flexible arm, a flexible element extending through the plurality of links and the base link, and a tensioning device movable between at least a first position and a second position, the first position tensioning the plurality of links to lock the plurality of links in a fixed position, the second position permitting the plurality of links to move relative to one another; wherein the base link has a proximal end and a distal end, and the base link is aligned with the body at the proximal end along a first axis and is aligned with one of the plurality of links at the distal end along a second axis, and the second axis forms an angle with the first axis of between 45 and 90 degrees.

Applicants submit that the Examiner has failed to establish a prima facie case of obviousness with respect to the rejections of claims 24 and 50. The Examiner has the burden of presenting evidence that the claimed elements were known in the prior art. See In re Lee, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). Neither Milo nor Hu teach or disclose the

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invention described in independent claims 24 or 50. The Examiner states that Milo does not teach the base link element described in each of claims 24 and 50, but points to Hu as showing the use of a device having such a base link. The Examiner, however, fails to demonstrate where Hu provides such evidence. Applicants have scanned Hu and cannot locate any element that satisfies the claimed base link element:

base link having a proximal end and a distal end, and being aligned with the body on the proximal end along a first axis and being aligned with one of the plurality of links on the distal end along a second axis, wherein the second axis forms an angle with the first axis of between 45 and 90 degrees

Rather than utilizing an arm having a plurality of links, Hu uses a shaft 3 that is slidable relative to mount assembly 20. As a result, there is no need for a base link that connects the body to the plurality of links. Hu does describe an arcuate wedge 544 that resembles in some respects the claimed base link. Wedge 544 is not however aligned at its proximal end with a body and on its distal end with a plurality of links. To meet the requirements of the claimed base link element, wedge 544 of Hu would at least need to be aligned with mount assembly 20 at its proximal end, and it is not.

Because the Examiner has failed to meet the prima facie burden of demonstrating that each of the claimed elements is taught in the cited prior art, Applicants submit that the rejections should be withdrawn.

Further, as to the rejection of claims 25, 27 and 28, the Examiner cited In re Aller, 105 USPQ 233 (CCPA 1955) as standing for the proposition that it would be obvious to one skilled in the art to reach an optimum range or value and In re Boesch, 205 USPQ 215 (CCPA 1980) as standing for the proposition that an optimum value of a result effective variable involves only routine skill in the art. Boesch is applicable to cases involving result-effective variables, which is not the case in any of these claims. Aller held that a claimed process performed at particular temperature and acid concentration was prima facie obvious over prior art that disclosed a range of temperature and acid concentrations, even though particular temperature and acid concentration were outside the prior art ranges. Aller also is not applicable to the facts of the case. Thus, the cases cited by the Examiner to support the rejections are not analogous to the facts at hand, and Applicants respectfully request the withdrawal of the rejections.

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As to the rejection of claim 26, Applicants submit that claim 26 is patentable at least because it depends from patentable claim 24.

If the Examiner believes that a discussion of the pending claims would expedite the prosecution of this application, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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